

### REMARKS

In the first Office Action, claims 1, 2, 5-6, 10-11, and 13-15 were present for examination with claims 3-4, 7-9, and 12 being withdrawn pursuant to a restriction requirement. All of the elected claims were rejected.

With this amendment, independent claim 1 and dependent claims 10-11 have been amended, dependent claims 2 and 14 have been cancelled, and new dependent claims 16-22 have been added.

#### Amended Independent Claim 1

Original claim 1 was rejected under 35 USC 103 with the Examiner stating:

Regarding [claim 1], Hoyt et al. discloses a golf tool comprising a support structure (12a,12b) that is obviously capable of functioning as a ball marker and divot repairing tool (22) that is rotatable about an axis between a first stored position and a second usable position. It would have been obvious to one of ordinary skill in the art to form the tool in a circular shape in order to reduce the number of edges of the tool and facilitate insertion of the tool in the user's pocket. (emphasis added)

This rejection is respectfully traversed.

The present invention is directed to a combination ball maker and divot repairing tool wherein the body of the ball marker has the traditional circular shape of a ball marker and the prod of the divot repairing tool in its retracted position is substantially within the circular perimeter of the ball marker so that the dominant appearance of the combination is still of a circular shape. The device of Hoyt et al. clearly does not have a "ball marker with a substantially disc-shaped body having a substantially circular perimeter" as now recited in amended independent claim 1. Hoyt et al. also clearly does not have a prod that is retractable to a position substantially within this circular perimeter of the disc-shaped body of the ball marker. Rather, Hoyt et al. has a banjo-shaped body of two sections (12a,12b) spaced from each other to create a hollow cavity therebetween to

receive a scoring wheel 18 and brush 20 and to support the other features of their device.

As recognized by Hoyt et al., the odd banjo-shape of their device is important to the operation of their multi-featured invention and its relative compactness (palm size). Their independent claim 7 even recites that their body "is longer than it is wide" and they refer to their body in their specification as having a "forward end" and a "rear end" (lines 23-25 of column 3) with "the first end being enlarged and rounded and the second end is narrower than the first end" (lines 47-50 of column 1). They obviously did not contemplate having a circular body. Among other things, if their body were made circular at its widest dimension in their Figure 1, it would easily be two or three times its present size. Without having the significant cut-away portions 40a,40b about the perimeter of their body, their scoring wheel could not be rotated as designed by them. Reducing the edges of their device as proposed by the Examiner to facilitate inserting their device into one's pocket is clearly not taught nor suggested by Hoyt et al. as they specifically attach a belt clip 66 to their body to enable their device to be "clipped to a golfer's belt."

Further and perhaps more fundamentally, Hoyt et al. clearly do not even contemplate using their device as a "ball marker" as they have a separate and removable ball marker 26 for that express purpose. In this regard, their disclosure and claim 8 specifically call for a hole in the body of their device "for receiving a [separate] ball marker." It would then seem to follow that this is why their device does not have the basic design features or shape of applicants' invention, particularly as now recited.

Applicants' combining of a retractable prod mounted to a disc-shaped ball marker with a traditional circular body is simply not taught or suggested by Hoyt et al. or the other prior art of record, nor would one skilled in the art have any motivation other than applicants' teaching to do so. It simply is not understood how the Examiner could have applied Hoyt et al. to original claim 1. Further, Hoyt et al. would appear to be even less relevant to independent claim

1 as now amended. Allowance of independent claim 1 as now amended is respectfully requested.

**Dependent Claims 5-6, 10-11, 13, and 15-22**

Original dependent claims 5-6, 10-11, 13, and 15 recite further details.

New dependent claims 16-18 depend from original dependent claim 15 and recite that one of the at least two tines of the prod is longer than the other (claim 16), the prod has at least three tines (claim 17), and two of the three tines are substantially the same length and the third is longer than the other two (claim 18).

New dependent claims 19-20 further recite that the prod has a substantially circular perimeter (claim 19) with its perimeter being substantially the same size as that of the disc-shaped body of the ball marker (claim 20). New dependent claim 21 depends directly from independent claim 1 and recites that the perimeters of the prod and disc-shaped body of the ball marker are substantially the same size. Although the claimed combination could have more than two pieces, dependent claim 22 specifically recites that the combination is a two-piece combination consisting of the disc-shaped ball marker and prod.

**SUMMARY**

It is respectfully submitted that all of the claims now present in the case (claims 1, 5-6, 10-11, 13, and 15-22) are in condition for allowance and such action is respectfully requested. If, in the opinion of the Examiner, prosecution of this application could be expedited by a telephone interview, the Examiner is respectfully requested to contact the attorney for the applicants at the telephone number listed below.

Please charge any additional fees due or credit any refund to Account No. 04-1414.

Respectfully submitted,

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